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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,933	05/23/2001	Maurice Eduardus Theodorus van Esbroeck	V0028/258607-	9991

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EXAMINER
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ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Offic Action Summary

Application No.	Applicant(s)
09/863,933	van Esbroeck et al
Examiner	**Group Art Unit**
George. Young	1761

—The MAILING DATE of this communication appears on th cover sheet beneath the correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on Feb. 5, 2003.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-53 are pending in the application.

Of the above claim(s) 6-37 are withdrawn from consideration as a non-elected invention.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 38-48 and 50-52 are rejected.

☒ Claim(s) 49 and 53 are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☒ Notice of Reference(s) Cited, PTO-892

☐ N tice of Draftsperson's Patent Drawing Review, PTO-948

☐ Intervi w Summary, PTO-413

☐ N tice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

DETAILED ACTION

Applicants' election with traverse of the invention of Group I (method claims 1-5 and 38-53) in Paper No. 7 is acknowledged. The traversal is on the ground that examination of elected Group I will necessarily require the same field of search necessary for examination of Group II, and that the presence of both inventions in a single application therefore imposes no undue burden on the Examiner. This is not found persuasive because the limitation limiting the apparatus to molding three-dimensional products from a mass of foodstuff is not given patentable weight, since the patentability of apparatus claims does not depend on the nature of the material being worked on. Moreover, the apparatus as claimed is separate and distinct from the method since the apparatus is incapable of determining the material acted upon during operation. See 1894 DC 238 at p. 244, U.S. Supreme Court. Therefore, the apparatus as claimed in applicants' claims 6-37 can be employed to practice another and materially different process, e.g., for use in molding soap or plastic material into shaped products. See U.S. patents 2,354,000 and 2,052,061 cited by the Examiner herein. Since the material upon which the apparatus performs its function can be different than a foodstuff mass, the method of claim 1 is not automatically performed when the apparatus of claims 6-37 is employed. Separate classification shows that each distinct subject has attained recognition in the art as a separate subject of inventive effort. See MPEP 808.02.

Because the inventions are distinct for the reasons given above, the search and examination of both inventions would not be coextensive. The issues raised in the

examination of apparatus claims are divergent from those raised in the examination of method claims. Further, while there may be some overlap in the searches of the two inventions, there is no reason to believe that the searches would be identical. Therefore, based on the additional work involved in searching and examining both distinct inventions together, restriction of the distinct inventions is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

The abstract of the disclosure is objected to because it is not limited to a single paragraph. Correction is required. See MPEP § 608.01(b).

The specification is objected to because the phrase "one or mould cavities" appearing at page 16, line 11, is incomplete. Correction is required.

Claims 39, 41, 42 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention for the following reason:

There is no antecedent basis for "the drum" recited in claim 39, lines 2-3.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 5, 38, 39 and 43-48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Israel.

Claims 2-4, 40-42 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel. It is not deemed that the features recited in dependent claims 2-4, 40-42 and 50-52 would define unobvious subject matter over the teaching of Israel in the absence of any new or unexpected results. The features recited in these dependent claims are considered to be obvious matters of routine optimization or structural design well within the skill of an ordinary artisan in the field of food technology.

Claims 1, 5, 38, 39 and 45-48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Benham et al.

Claims 2-4, 40-44 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benham et al. It is not deemed that the features recited in dependent claims 2-4, 40-44 and 50-52 would define unobvious subject matter over the teaching of Benham et al in the absence of any new or unexpected results. The features recited in these dependent claims are considered to be obvious matters of routine optimization or

structural design well within the skill of an ordinary artisan in the field of food technology.

Claims 1, 5, 43 and 44 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Leadbeater (Canadian patent 2,302,915).

Claims 49 and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Craig et al patent is cited to show an apparatus for molding soap. The Toelke patent is cited to show a molding device for molding plastic materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner George Yeung whose telephone number is (703) 308-3848. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

G. C. Yeung/mn
June 4, 2003

GEORGE C. YEUNG
PRIMARY EXAMINER